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09/672,152	09/27/2000	Thomas D. Nord	2094B	6622

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EXAMINER

LONEY, DONALD J

ART UNIT	PAPER NUMBER
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1772

DATE MAILED: 01/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/672,152

Applicant(s)

NORD ET AL.

Examiner

Donald Loney

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on the amendment filed October 9, 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-51 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-51 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 20.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-44 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1, 4, 14 and 29 contain Markush groups wherein the members are not mutually exclusive. For example, elliptical and oval are not mutually exclusive since an oval is an ellipse (see page 836 of Webster's II Dictionary Cited by the examiner). The rounded also does not appear mutually exclusive of the oval and/or elliptical. The examiner also questions what the term "rounded" refers to? It appears this may have been meant to be "round". Clarification is kindly requested so that prior art may be properly applied. Is it referring to part of the cross-section? The examiner believes this includes cylindrical structures and circles and will apply art that encompasses this structure. Would this include D shaped structures since they would have at least part that would be rounded?

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

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A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1-44 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-14 of U.S. Patent No. 6,340,514. Although the conflicting claims are not identical, they are not patentably distinct from each other because the foam rubber contains cylindrical protrusions, which are overlapping with applicant's Markush Group since the term rounded is still present (see 35 USC 112 rejection above).

5. Claims 1-51 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-32 of U.S. Patent No. 6,589,631. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 4 and 16 contain oval, elliptical octagonal as in instant claims 1 and 14. Instant claims 45-51 also fail to distinguish since polygons are also included in Markush Group.

6. Claim 1 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 2 of U.S. Patent No. 6,296,919. Although the conflicting claims are not identical, they are not patentably distinct from each other because the cylindrical protrusions are round in shape as in the instant Markush Group.

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7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 1, 4, 5, 8, 11, 29, 37, 38, 39, 40, 41, 43 and 44 are rejected under 35 U.S.C. 102(b) as being anticipated by Cerlani as presented in the last office action mailed May 9, 2003.

Cerlani teaches a foam rubber with protrusions on the back and/or front surface. Refer to Figures 2, 3A, 3B, and 3C. Fig. 3C shows a projection, which is cylindrical at the top and tapered down there from (i.e. conical). The cross section of the projections of Fig. No. 3c would be circular, which would meet the "rounded" limitation included in the applicant's Markush group as explained in the 35 USC 112 rejection above. The tops of the projections are also rounded meeting the textured limitation for the top thereof.

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10. Applicant's arguments filed October 9, 2003 have been fully considered but they are not persuasive. The applicant argues that the double patenting rejections be withdrawn in view of the amendments filed October 9, 2003. This is not persuasive since the claims contain subject matter as indicated that is substantially the same as discussed above in relation to the rounded, oval elliptical and polygonal.

11. In response to applicant's argument that Ceriani does not teach a floor mat, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

12. In response to applicant's arguments, the recitation a "floor mat" in relation to the rejection over Ceriani has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

New art rejections

13. Claims 45-51 are rejected under 35 U.S.C. 102(b) as being anticipated by Engst.

Engst teaches a mat with form rubber layer (3) that has polygonal (i.e. square) protrusions that also contains two more solid rubber layers (10, 12). Refer to Figures 1, 2, and column 2, lines 14-34, column 4, lines 24-48 and column 5, lines 1, 2, 18-25. The sections 4 there between appear to be planar as recited. The recitations as to the protrusions on the front side or backside are met since this only a matter of which way the mat is oriented and looked at (from the top or bottom). This is a limitation that is the same as discussed in the response to the applicant's argument that this is intended function as discussed above. The roughened, dimpled or textured limitations are all met by holes 5 shown in figure 1 since this is a texture caused by an opening.

14. Claims 45-47 are rejected under 35 U.S.C. 102(b) as being anticipated by Ceriani.

Ceriani teaches a foam rubber article that has projections that are polygonal (they appear rectangular in figure 3B) in cross section. The limitation as to the top or bottom surface containing the projections has been discussed above in the Engst rejection.

Claim Rejections - 35 USC § 103

15. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

16. Claims 1,2,3,4,5,7,8,11,27,36,37,38,39,40 and 42-44 are rejected under 35

U.S.C. 103(a) as being unpatentable over Engst.

Engst teach a mat with form rubber layer (3) that has polygonal (i.e. square) protrusions that also contains two more solid rubber layers (10, 12). Refer to Figures 1, 2, and column 2, lines 14-34, column 4, lines 24-48 and column 5, lines 1, 2, 18-25. Engst fails to teach the oval, elliptical and/or rounded projections. However, Engst does disclose that other forms of the projections can be used. Refer to column 5, lines 1 and 2.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to Engst to form the projections of any of oval, elliptical, rounded, octagonal, letters and /or numbers since Engst teaches that forms other than squares can be used and they would impart the same cushioning effect thereto. A mere change in shaped or size is within ordinary skill in the art.

17. Applicant's arguments with respect to new claims 45-51 have been considered but are moot in view of the new ground(s) of rejection.

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald Loney whose telephone number is 571 272-1493. The examiner can normally be reached on Mon.-Fri. 8AM-4PM, maxiflex schedule.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on 703 308-4251. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 308-0661.

A handwritten signature in black ink, appearing to read "Donald Loney", with a stylized flourish at the end.

Donald Loney
Primary Examiner
Art Unit 1772

DJL:D.Loney
12/29/03